The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN KIKINIS

Application 08/811,648

MAILED

JAN **2 8** 2005

U.S. PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

ON BRIEF

Before BARRETT, FLEMING, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, Administrative Patent Judge.

REMAND TO THE EXAMINER

We remand this application to the Examiner for consideration of the following matters.

I. Whether a rejection of claims 1-4, 7-9, and 14-17 under 35 U.S.C. § 112, first paragraph is appropriate.

II. The Dates The Examiner Accorded The Present Application

And The Applied Prior Art When Formulating The Rejections

Under 35 U.S.C. § 102 and 35 U.S.C. § 103.

I. Whether A Rejection Of Claims 1-4, 7-9, and 14-17 Under 35 U.S.C. § 112, First Paragraph Is Appropriate.

We have reviewed Appellants' specification as originally filed and find subject matter in the claims before this Board that fail to comply with the written description requirement. The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

We discuss claim 1 as exemplary of the problems in claims 1 and 7. Claim 1 recites a "bridge adapter unit . . . having an inlet port." We find no description indicating that micro-PBX 301 (the bridge adapter unit of claim 1) has the specific structure of an inlet port. Claim 1 recites "a telephone wiring structure . . . connected at a single point to an outlet port of the bridge adapter unit." We find no description indicating that micro-PBX 301 (the bridge adapter unit of claim 1) has the specific structure of an outlet port. Further, we find no description indicating that the telephone wiring structure is

connected at a single point. Claim 1 recites, "the bridge adapter unit drives the telephone wiring structure." We find no description indicating that the micro-PBX 301 performs the specific function of "driving" the telephone wiring structure. Claim 1 recites "the bridge adapter unit . . . translates all received public network protocol signals, regardless of protocol." Although the disclosure teaches that the micro-PBX 301 performs translation, we find no description indicating that the micro-PBX 301 performs the function of translating in such a universal manner.

Lastly and most importantly, claim 1 recites "the bridge adapter unit . . . modulates the signals in a manner to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter unit."

We find no description indicating that this function is performed by any component in the original disclosure.

The record before us does not mention nor address these problems in any way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we remand for consideration of this issue.

II. The Dates The Examiner Accorded The Present Application And The Applied Prior Art When Formulating The Rejections Under 35 U.S.C. § 102 and 35 U.S.C. § 103.

In the final rejection the Examiner rejected claims 1-4, 7-9, and 14-17 of the present application filed March 5, 1997, under 35 U.S.C. § 102 and 35 U.S.C. § 103 as being anticipated by and obvious over Foley, U.S. Patent 6,069,899, filed August 28, 1997. We note that Foley, U.S. Patent 6,069,899, does not claim any continuity to an earlier filed U.S. patent or application.

The record before us does not mention nor address in any way the fact that the application that resulted in the Foley patent was filed after the application presently on appeal before this Board. Therefore, we request that the Examiner clarify the record and explain why Foley, U.S. Patent 6,069,899, is available as prior art to the present application.

Accordingly, we remand for consideration of this issue.

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Conclusion

If reconsideration by the examiner does not promptly result in the withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the board so that the appeal may be restored to its existing place in the order in which appeals are decided. In the event that the examiner returns this application to the jurisdiction of the board following reconsideration, a new appeal number will be assigned. However, a new appeal fee will not be required.

This application, by virtue of its Special status, requires *immediate* action by the examiner. See MPEP § 708.01(d). The Board of Patent Appeals and Interferences *must* be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

REMAND

Lee E. Barrett)	
Administrative Patent Judge)	
MICHAEL R. FLEMING Administrative Patent Judge))))	BOARD OF PATENT APPEALS AND INTERFERENCES
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ALLEN R. MACDONALD Administrative Patent Judge))	

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